

REMARKS

Applicant wishes to thank Examiner for the phone interview conducted on November 9, 2006.

The following remarks are prepared in response to the final Office Action of September 29, 2006. Claims 1-7, 9-16 and 18-28 remain pending in this application, after entry of this amendment. Reconsideration in light of the remarks made herein is respectfully requested.

The final Office Action rejected Claims 1-7, 9-16, and 18-28 under 35 U.S.C. 103(a) as being unpatentable over *Porcher* (U.S. 4,702,022) in view of *Dalvy et al.* (U.S. 5,924,218), *Mashita et al.* (U.S. 5,681,649), *Finn* (U.S. 3,410,004), and *Farrior* (U.S. 6,691,431). Applicant respectfully traverses.

As the Examiner is aware, the hard question is whether the combination is based upon hindsight from the present teaching rather than what would be obvious apart from the present teaching to a person of ordinary skill in this field.

As set forth in *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006):

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. [*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).]

To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law. . . .

* * *

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as “the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be *some* articulated reasoning with *some* rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decision making, as it is in §103.

As can be appreciated, the more the cited references must be modified to meet the outstanding claims, the more likely that an unintended issue of hindsight may drive the rejection. This is particularly true for an Examiner who is attempting to provide a diligent effort to ensure that only patentable subject matter occurs. The difficult issue is to step back from the zeal of the examination process and to appreciate that the Patent Examiner has to wear both hats of advocating a position relative to the prior art, while at the same time objectively rendering in a judge-like manner, a decision on the patentability of the present claims.

Independent Claims 1, 18, 23, and 28

Porcher is a reference seeking to improve the comfort of ski boots through the addition of inflatable cushions. (Col. 1, line 24 - Col. 2, line 10).

Farrior is a reference seeking to improve the aesthetic appearance of a dancer’s feet because aesthetics play an important role in ballet. (Col. 1, lines 10-20; Col. 1, line 61 – Col. 2, line 6). It accomplishes this by “attaching a pad that has a curved top surface to the top of a dancer’s foot” with the result being that the “shape of the top of the dancer’s foot is improved” and the “arch on the bottom of the foot appears more marked.” (Col. 1, line 67 – Col. 2, line 7).

Thus, a pad 40 which is gradually tapered in a direction outward from the center is added to the top of the ballet shoe to improve the aesthetic appearance of the foot. (Figure 5; Col. 5, lines 35-44).

The present invention aims to provide added comfort for users of boots such as snowboarders and skiers. It accomplishes this *inter alia* by providing gel pad 25 and heel pad 30 that are tapered and embedded between the layers of the boot liner at the toe box and the heel area as shown in Figure 2. As can be seen in Figures 3 and 4, heel pad 30 is tapered to afford protection to the back of the heel and to improve comfort to the user. (Spec. pg. 6, lines 22-23; pg. 7, lines 27 - 30). As can be seen in Figures 5 and 6, gel pad 25 is tapered to afford protection to the toes and to improve comfort to the user. (Spec. pg. 8, lines 3-12).

Thus, a person seeking to improve the comfort of a boot for snowboarding or skiing would certainly not look to a reference for improving the aesthetic appearance of a ballet dancer's foot for inspiration. This is especially apparent given that they are two different types of shoes and also serve diametrically opposing functions of comfortable shoe versus aesthetically pleasant foot. In addition, *Farrior* teaches away from the present invention as the present invention's goal is to provide comfort to the user while the invention in *Farrior* seeks to improve the aesthetic appearance of the user's foot. It is well known that comfort usually improves at the expense of aesthetics and vice versa. Furthermore, if the pads 40 in *Farrior* were embedded in the liners of a shoe, they would lose all aesthetic appeal since they are not visible anymore to the outside world and would not aid in improving the shape of the dancer's foot. Thus, there is no motivation to combine the references apart from the teachings of the present invention.

Furthermore, even if the references were combined, however improperly, the resulting combination would not produce a tapered gel pad embedded between liners of the shoe to

improve comfort. *Farrior*'s invention does not teach or suggest positioning the pad in the toe box area or the heel counter area as recited in the independent claims. *Farrior* places the pad 40 on top of the shoe to improve aesthetic appearances. Thus, if the references were combined, the resulting combination would be a ski boot with a pad on top to improve the aesthetic appearance of the user's foot. It would not be a tapered gel pad embedded between liners of the shoe to improve comfort.

Therefore, Applicant respectfully requests that this rejection be withdrawn.

Dependent Claims 2-7, 9-16, 19-22, and 24-27

Dependent claims 2-7, 9-16, 19-22, and 24-27 depend from independent claims 1, 18, 23, 28 and thus are allowable.

Conclusion

If the Examiner believes that a telephone interview will help further the prosecution of this case, she is respectfully requested to contact the undersigned attorney at the listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.



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